



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAME INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,418	12/16/1999	GEOFFREY B. RHOADS	60075	8844

217:5 7590 11/27/2002

DIGIMARC CORPORATION
 19801 SW 72ND AVENUE
 SUITE 100
 TUALATIN, OR 97062

EXAMINER

MILLER, MARTIN E

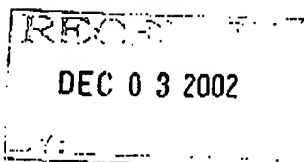
ART UNIT

PAPER NUMBER

2623

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Docketed: 2.27.03Book: Init: SEP

Best Available Copy

Office Action Summary

Application No.

09/465,418

Applicant(s)

RHOADS ET AL

Examiner

Martin Miller

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6. 6) ☐ Other: ____.

Application/Control Number: 09/465,418
Art Unit: 2623

Page 2

DETAILED ACTION***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5 and 14 are, drawn to a security document recognition system that signals a web browser to access a website related to the security document, classified in class 382, subclass 135.
 - II. Claims 6-13 are, drawn to recognizing graphic, video or audio data as belonging to a particular class of data and directing the user's computer to a related website, classified in class 709, subclass 218.
 - III. Claim 15 is, drawn to providing updated software to a user's computer, classified in class 713, subclass 1.
 - IV. Claim 16 is, drawn to method of digital watermarking based upon changing the luminosity of a printed image, classified in class 382, subclass 100.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention II does not require the use of a document that clearly does not contain

Application/Control Number: 09/465,418
Art Unit: 2623

Page 3

video information, to be patentable and copy prevention has separate utility by itself. The subcombination has separate utility such as a multimedia means to provide a user additional information regarding the graphic, video or audio data that is being processed on a user's computer.

Inventions I, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, Invention I is directed towards reading a security document, Invention III is directed towards updating a computer user's driver software, while Invention IV is directed towards digitally watermarking a document by changing luminosity.

Inventions II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, Invention II is directed towards providing additional data about graphics, video, or audio data being processed on a user's computer via a website, Invention III is directed towards updating a computer user's driver software, while Invention IV is directed towards digitally watermarking a document by changing luminosity.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with William Conwell on November 15, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5

Application/Control Number: 09/465,418
Art Unit: 2623

Page 4

and 14. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 6-13 and 15-17 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

5. The examiner has considered the three IDS filed July 21, 2000, February 2, 2001 and April 16, 2001 and an initialed copy of each is included with this office action. The three Information Disclosure Statements are stapled together.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Application/Control Number: 09/465,418

Page 5

Art Unit: 2623

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al., (hereinafter Russell), US 5905248 and Mowry, Jr. (hereinafter Mowry), US 5951055.

As per claim 1, Russell teaches:

recognizing a document (transaction cards, other printed media, col. 2, ll. 57-59) and, in response, directing (accessing) a web browser to a website related thereto (col. 2, ll. 57-62).

Although it is arguable that a transaction card (e.g. gift card, credit card) is equivalent to a security document because it performs substantially the same function in the same manner, and Russell teaches that other types of print media can be used to conduct financial transactions with his system (col. 20, ll. 23) with his system and that other security functions can be performed (col. 19, ll. 49-50), Russell does not specifically teach recognizing a "security document". But Mowry does teach recognizing a security document with a hidden security image and a machine-readable code, col. 4, ll. 53-55.

It would have been obvious to one of ordinary skill in the art to use the security document hidden images and machine-readable codes as the "other printed media" of Russell so as to provide another use of Russell's system, which is particularly useful because Russell teaches a hand-held version that could be used by merchant's and consumers not only to prevent unauthorized reproduction, but also to prevent passing off the unauthorized copy. Additionally, the system of Russell teaches that his system can be used to direct a user to information

Application/Control Number: 09/465,418

Page 6

Art Unit: 2623

resources (col. 25, ll. 7-14) in order to more effectively carry out the information-related transactions.

As per claim 2, Mowry teaches:

presenting to a user a substitute ("pseudo originals") image from the website (col. 5, ll. 7-10).

As per claim 3, Russell teaches:

presenting a user with supplemental information ("particular type of information-based transaction") relating to the recognized security document, or to its permitted use, from the web site (col. 2, ll. 56-60). Clearly, during an information-based transaction, information must be exchanged between the user and computer system being accessed.

As per claim 4, Russell teaches that his system uses machine-readable barcodes (col. 8, ll. 55-65) and does not specifically mention a digital watermark. However, Mowry teaches the use of digital glyphs. Therefore, Mowry teaches:

the use of recognizing a security document by a digital watermark encoded therewith (col. 1, ll. 22-26, col. 4, ll. 32-35, 53-54). Mowry also teaches that other information bearing elements other than digital glyphs can be encoded in the security document so long as it is not recognizable by the unaided human eye, which also serves the purpose of not detracting from the aesthetics of the security document. Preserving the aesthetics of the security document is also an objective of the applicant (See specification page 2, ll. 9-11). Additionally, the specification states that the anti-counterfeiting system markings can be added to existing documents as an ink-marking (See specification page 2, ll. 11-15) just like Mowry's digital glyphs

As per claim 5, Russell teaches:

Application/Control Number: 09/465,418
Art Unit: 2623

Page 7

a computer storage medium having instructions stored thereon for causing a computer to perform the method of claim 1 (Figure 1, element 6A, "client computer", col. 2, l. 56.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry.

Mowry teaches:

receiving first image data (attempted copy, col. 4, ll. 64-66);

substituting second image data ("pseudo original", col. 5, ll. 7-10) for the first image data,

But Mowry does not specifically teach "the second image data being an image of play money.

However, It would have been obvious to one of ordinary skill in the art to substitute whatever pseudo original image would most effectively convey the information that the document reproduced is not negotiable. Whether this image is merely the word "VOID" printed over the document or Mickey Mouse's face in place of President Lincoln's on a five-dollar bill, it is merely a choice of the system designers to decide. If fact a play money image would be closer to a pseudo original than a bill marked by the word "VOID" because play money is more of a sham than a bill marked with "VOID".

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U.S. patent(s) refer(s) to copy prevention and managing such a system: Masuyama, 5771315, Hashimoto, 6137987, Tachikawa et al., 5659628, Durst et al., 6,108,656, Reber et al., 5986651, Boutaleb et al., 4536014, Rhoads, 6311214.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Miller whose telephone number is (703) 306-9134. The examiner can normally be reached on Monday-Friday, Maxi-flex.

Application/Control Number: 09/465,418
Art Unit: 2623

Page 8


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

mem

mem

November 25, 2002


Jon Chang
Primary Examiner